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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *17 January 2006*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-3,5-13,15-19,21 and 23-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-3,5-13,15-19,21 and 23-27* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Action Background

1.   This action is responsive to the applicant's amendment, filed on 1/17/2006.

2.   Applicant has cancelled claims 4, 14, 20 and 22, and amended claims 1, 5-11, 15-19, 21 and 23-27.

3.   Claims 1-3, 5-13, 15-19, 21 and 23-27 are pending in the case, claims 1, 11 and 21 are independent claims.

4.   Examiner's rejection of claims 4, 14, 20 and 22, made under 35 USC 102 or 35 USC 103 as being anticipated by Krug et al. US Patent 6,721,736, or as being unpatentable over Krug in view of Li, US Patent 6,691,108 as recited in the previous office action (dated 10/17/2005) are withdrawn in view of the cancelled claims.

5.   Examiner's rejection of claims 1-3, 5-13, 15-19, 21 and 23-27, made under 35 USC 102 or 35 USC 103 as being anticipated by Krug et al. US Patent 6,721,736, or as being unpatentable over Krug in view of Li, US Patent 6,691,108, or as being unpatentable over Krug in view of Li, in further view of Arnold et al., US Patent 6,745,161, or as being unpatentable over Krug in view of Arnold as recited in the previous office action (dated 10/17/2005) are withdrawn in view of the amended claims. However new grounds of rejection are described below.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

"*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*"

7.   Claims 1-3, 10-13 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8.   **Regarding claims 1-3, 10-13 and 21**, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "*useful, concrete and tangible result.*" *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward a method of presenting structured digital content. Applicant's claims describe the steps taken to manipulate the

nonfunctional descriptive material (i.e. reading a file, mapping categories to a

display, receiving user input, determining, and mapping content to a display),

but fail to claim a practical application for the categories or content mapped to

the display. However, applicant's invention includes the step of <u>displaying</u> the

categories and the content as shown in figures 2, 3a and 3b, and the related

sections of the specification on pages 6-16. Incorporating the displaying

feature, as described in the specification, into applicant's claimed invention

would provide a practical application for the mapped categories and mapped

content.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> *"(a). A patent may not be obtained though the invention is not identically*
> *disclosed or described as set forth in section 102 of this title, if the*
> *differences between the subject matter sought to be patented and the*
> *prior art are such that the subject matter as a whole would have been*
> *obvious at the time the invention was made to a person having ordinary*
> *skill in the art to which said subject matter pertains. Patentability shall not*
> *be negatived by the manner in which the invention was made."*

10.   Claims 1-3, 5, 10, 11-13, 15, 21 and 23 are rejected under 35

U.S.C. 103(a) as being unpatentable over the Yahoo search engine (as

provided by the Way-Back-Machine, including examples of the Yahoo search

engine from 11/18/1999, 3/6/2000 and 6/8/2000 – Hereinafter Yahoo) in view

of Krug et al. US Patent 6,721,736, filed 11/15/2000, patented 4/13/2004 (hereinafter Krug).

11.   **Regarding independent claim 1,** Yahoo discloses a hierarchical structure defining a plurality of layers, where the layers are associated with categories in the web page shown on Page 3. For instance the *"Government"* category shown in the middle of the page, on the left, contains the subcategories of *"Elections"*, *"Military"*, *"Law"* etc. The *"Government"* category is the higher layer category, and the *"Elections"*, *"Military"*, *"Law"* subcategories are the next-lower layer of categories. Yahoo discloses mapping the categories to areas on the display (shown as textual links as described above). Yahoo discloses receiving the selection of a first display location from a user, determining if the first display location is associated with a next lower layer of categories, and if so, then displaying those subcategories, if not than displaying the content. As is well known in the art, and shown by Yahoo on page 3, the user would select categories (for instance *"Government"*), which would display a new screen showing subcategories or content. This provides for an iterative process, where the user could navigate into lower subcategories or to content.

Yahoo discloses presenting structured digital content items, as described above. Yahoo fails to disclose the presenting process as enabled by a first file that defines the hierarchical structure, and one or more second files that provide the content. Krug discloses a metadata search engine that is enabled by a first structure file, and a plurality of content files. Krug discloses reading

a first file defining a hierarchical structure for presenting digital content items, where the hierarchical structure defines a plurality of categories into which the digital content items are classified. Krug recites: *"FIG. 7 shows the HTML syntax tree provided by the syntax tree parser 20 corresponding to the search result frame 68 of FIG. 6. The syntax tree is the basis for all further procedures. In the preferred embodiments, the syntax tree parser is executed by a module of the interpreter programming language PERL. In the hierarchical syntax tree 76, the HTML tags are arranged in order of their appearance in the documents while their dependence on other tags 70 is represented by their level 78"* (column 10, lines 17-25).

Krug discloses reading a plurality of second files, where the second files defines at least one digital content item to be presented according to the hierarchical structure, and where the second file corresponds to one of the plurality of categories in Figure 2 at reference sign 14 (shown as *"Hits"*).

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to implement the categorized content of Yahoo wit the first and second files of Krug in order to "improve the quality of the information retrieval process in the Internet" (Krug, column 2, lines 40-41).

12.   **Regarding dependent claim 2**, Krug discloses an XML schema file. Krug recites: *"In the preferred embodiments, the search responses are encoded in either one of the markup languages HTML or XML. Documents encoded in these languages can be viewed as a sequence of markups (tags) placed within the text defining the format and layout of the text. In this context, the*

term "syntax" and accordingly "syntax element" refer to the representation of these markups within the text and their specific meaning. A syntax pattern is a certain sequence of such syntax elements, where the order and the relationship between the syntax elements are important features of the pattern. When displayed with an HTML or XML compatible browser (software tool for displaying Internet documents encoded in HTML or XML), changing one syntax element within an HTML or XML document usually has an effect on the appearance either with respect to the layout or the format of the corresponding part of the text" (column 4, line 59 to column 5, line 7).

13.   **Regarding dependent claim 3**, Krug discloses the second file as XML. Krug states that HTML and XML are equivalent. Krug recites: "*In the preferred embodiments, the search responses are encoded in either one of the markup languages HTML or XML*" (column 4, lines 59-61). Krug further recites: "*FIG. 6 shows a sample of HTML source code 68 corresponding to a particular search result frame 58*" (column 10, lines 6-7).

14.   **Regarding dependent claim 5**, as described above, Yahoo discloses receiving multiple selections (i.e. first, second third etc.) from the user, and displaying the related content in a second display location (i.e. in a new screen).

15.   **Regarding dependent claim 10**, Yahoo discloses receiving user input from a mouse. It is well known that a user would interact with the graphical user interface shown on page 3 of Yahoo, with a mouse, and that the use of a

mouse or other pointing device is commonplace within the computer related

arts.

16.   **Regarding claims 11-13 and 15**, the claims are directed toward a

computer-readable medium for the method of claims 1-3 and 5, and are

rejected using the same rationale.

17.   **Regarding claims 21 and 23**, the claims are directed toward a system,

for the method of claim 1 and 5, and are rejected using the same rationale.

18.   Claims 6-9, 16-19 and 24-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yahoo in view of Krug, and in further view of Arnold et al.

US Patent 6,745,161, filed 7/10/2000, patented 6/1/2004 (hereinafter Arnold).

19.   **Regarding dependent claims 6-9**, Yahoo and Krug disclose hierarchical

structured content with categories and layers, as described above. Yahoo and

Krug fail to disclose storing an indication of the selected content (claim 6),

storing the indication in the second file (claim 7), storing the indication in a

third file (claim 8) or storing the indication in the first file (claim 9). Arnold

discloses storing an indication of the selected file in Figure 7, at the bottom of

the figure where Arnold recites: "*Identified concepts and related information is*

embedded in the original source documents or in a proxy documents

containing concept tags".

Therefore it would have been obvious to one of ordinary skill in the art at

the time the invention was made to combine the storing of preferences as

taught by Arnold with the search engine teachings of Krug and LI in order to

provide a *"method that allows a user to easily obtain information via the Web.*

The method should allow a user to use natural language, and search based

on idea concepts" (Arnold, column 2, lines 38-41).

20.   **Regarding claims 16-19 and 24-27**, the claims are directed toward a

computer-readable medium and a system, respectively, for the method of

claims 6-9, and are rejected using the same rationale.

Response to Arguments

21.   Applicant's arguments with respect to claims 1-3, 5-13, 15-19, 21 and 23-

27 have been considered but are moot in view of the new ground(s) of

rejection, as described above.

Conclusion

22.   Applicant's amendment necessitated the new ground(s) of rejection

presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first

reply is filed within TWO MONTHS of the mailing date of this final action and

the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action.

In no event, however, will the statutory period for reply expire later than SIX

MONTHS from the mailing date of this final action.

23.   Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Gregory J. Vaughn whose telephone

number is (571) 272-4131. The examiner can normally be reached Monday to

Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124.

The fax phone number for the organization where this application or

proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status

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access to the Private PAIR system, contact the Electronic Business Center

(EBC) at 866-217-9197 (toll-free).

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Gregory J. Vaughn
March 30, 2006